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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,312	01/23/2004	Djoser Omowale	WYNNE-2	6533
25889	7590	05/03/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ALAVI, ALI	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,312

Applicant(s)

OMOWALE, DJOSER

Examiner

Ali Alavi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson (US Pat. No 4,466,742) in view of Chabria (US Pat. 5,730,539).

Lamelson discloses an illuminated writing implement comprising: (a) a substantially tubular body portion (11) a substantially tubular (16) head portion rotatably secured to said body portion, cap detachably secured to a top of said head portion (78), power source (battery 37) disposed in an interior of said head portion, light source (LED , col. 12, line 49) disposed in an interior of and electrically coupled to said power said head portion source; a display unit (LCD, col. 12, line 47) for displaying a time and date disposed on an outer surface of said head portion; a switch electrically coupled to said power source for setting a mode of operation of said light source, a switch (switch 27) electrically coupled to said display unit for setting a time and date to be displayed, a focusing ring rotatably secured to said body portion; (j) a substantially conically-shaped lens disposed at a lower end of said body portion (lens 23), and a marking element (13) disposed in an interior of the illuminated writing implement, said marking element having a tip which provided said lens, protrudes through an opening light source produces a beam of visible light which is transmitted through said lens, further comprising a

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message disposed on an outer surface of said body and on an outer surface of said cover (this is known in the art to have a marking or message as an advertising), said light source produces said beam of visible light only when a pressure is applied to said tip (col. 12 lines 50-64), said marking element comprises a pen refill insert (col. 4, line 45), further comprising at least one eraser head disposed on top of said marking element (101, fig. 14), further comprising a clip (14, fig. 1) disposed on an outer surface said head portion, further comprising a graphic image disposed on an outer surface of said clip (well known in the art to have a graphic image or marking on the clip of implement), said display unit may be illuminated (col. 12, line 47), said display unit comprises a liquid crystal display (col. 12, line 47), wherein said light source comprises a light emitting diode (col. 12, line 49), wherein said power source comprises a battery (battery 37). Lamelson teaches the claimed invention except for a window disposed at bottom end thereof, wherein said beam of light is transmitted through said window.

However, Chabria discloses a combination of writing implement and a flashlight having a lens at the bottom end of the implement which light transmitted through the lens.

Chabria teaches that it is desirable for investigators or emergency personnel to have a combined flashlight and writing implement in order to ease the reporting events without using a flashlight separately.

It would have been obvious to an ordinary skill in the art at the time of invention was made to provide a combined flashlight and a writing implement in order to make the device more compact and useful to reduce the cost and handling of the device as taught by Chabria.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim is objected to because in part recites "...wherein said light source produces said beam of visible light only when a pressure is applied to the tip." This feature was not taught or suggested by the prior art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liaw (US Pat. No 4,585,364), Kao (US Pat. No 6,719,473), and Chin-Hsiang (US Pat. No 5,475,575) are all cited of interest.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Ali Alavi** whose telephone number is **(571) 272-2365**. The examiner can normally be reached between 7:00 A.M. to 5:30 P.M. Tuesday to Friday. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached at (571) 272-2378 or you may fax your inquiry to the **Central Fax at (703) 872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ali Alavi", with a long horizontal stroke extending to the right.

Ali Alavi
Patent Examiner
AU 2875